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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,509	12/07/2006	Jordi Tormo i Blasco	5000-0160PUS1	2360

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EXAMINER
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PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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02/24/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,509	<b>Applicant(s)</b> BLASCO ET AL.	
	<b>Examiner</b> John Pak	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/2006</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

Claims 1-20 are pending in this application.

Claims 5 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 5 and 12 are improperly dependent on independent claim 1, either directly or indirectly. Claim 1 is directed to a mixture of compounds. Claims 5 and 12 are open to using the individual components of the mixture separately, i.e. not as a combined mixture. This makes these dependent claims improperly dependent on claim 1 since claim 1 is limited to the mixture.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 provides for the use of the compound (I) and sulfur, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 10 will not be further examined on the merits because it is directed to non-statutory subject matter, "[t]he use of" a substance.

Claims 9, 11-14 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 9 is directed to seeds comprising the mixture of claim 1 in an amount from 0.001 to 5 kg/100. Note that the "100" is missing a unit. In the absence of the unit, this feature could read on 100 seeds; however, all other claims in this application specify the seed application amounts per 100 kg of seed. The absence of the unit is therefore confusing and indefinite in claim 9.

(2) Claims 11-14 and 16-17 have lack of antecedent problems concerning "The." For example, claim 11 is recited as "The fungicidal composition" but its base claims only recite a fungicidal mixture. Similarly in claims 12-14 and 16-17, "The method" lacks antecedent basis because their base claims are only directed to a fungicidal mixture.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of EP 988790 and WO 98/46607 in view of the acknowledged prior art, Goddard (US 4,180,569) and Duvert et al. (US 5,977,156).

EP 988790 discloses the fungicidal combination of triazolopyrimidine compounds that encompass applicant's formula I compound + sulfur. See paragraphs 1 and 9, wherein R<sup>1</sup> and R<sup>2</sup> together with the nitrogen represent a 4-methylpiperidine ring and L<sup>1</sup>, L<sup>2</sup> and L<sup>3</sup> represent F. **Synergistic effect** from the combination is disclosed (paragraphs 3-4, 7, 15). Application to soil, **seeds** or directly onto plants is disclosed (paragraphs 15, 25). Protection of crops such as **rice**, vegetables, fruits, vines, and ornamentals against phytopathogenic fungi is disclosed (paragraphs 16-17). Control of phytopathogenic fungi of the genus **Cochilobolus** is disclosed (paragraph 16, second line of the paragraph). 0.001-2 kg/ha application rate of the triazolopyrimidine compounds is disclosed (paragraphs 18-19). Optimal rate of the second fungicidal active ingredient such as sulfur depends on the crop, level of infestation, and "can be readily determined by established biological tests." (paragraph 20). Ratio of 1:100 to

100:1 is disclosed for the two active fungicidal ingredients (paragraph 21). 0.001-99.9 wt% concentrations in various formulation types/carriers such as emulsions, solutions, powders, granules and other formulations are disclosed (paragraphs 22-35).

WO 98/46607 discloses the fungicidal activity of applicant's triazolopyrimidine of formula I. See page 3, lines 5-15; Example 2 on page 20. The compound is disclosed to have enhanced systemic activity and enhanced toxicity to fungi (page 7, lines 8-11). Various solid and liquid formulations are disclosed (pages 13-17). **Combined use, including synergistic effect/use, with myriad other fungicides is disclosed** (page 17, line 7 to page 19, line 2; see in particular page 17, lines 12-13). Combination with another fungicide such as **sulfur** is disclosed (page 18, line 14). Application to soil, seeds or directly onto plants is disclosed (page 19, lines 2-19). Protection of crops such as rice, solanaceous crops, vegetables, legumes, apples, vines against phytopathogenic fungi is disclosed (paragraph bridging pages 11-12; page 19, lines 14-16). 0.5-95 wt% concentrations in various formulations/carriers such as emulsions, solutions, powders, granules and other formulations are disclosed (page 12, lines 14-32; see also pages 13-15 for specific concentrations and formulation types). 0.01-10 kg/ha application rate is disclosed (page 15, lines 10-12).

Applicant acknowledges in the specification that both formula I compound and sulfur are known for their fungicidal properties, and triazolopyrimidine compounds that

encompass applicant's formula I compound are known to be combined with sulfur (specification page 1, lines 18-33).

Goddard and Duvert et al. are cited to merely show seed treatment application rates of other known fungicidal agents for rice seeds. Goddard discloses 16 to 500 g of active agent per 100 kg of rice seed (Example 8 on column 6). Duvert et al. disclose 2-200 g of fungicide per 100 kg of rice seeds (claim 32; column 5, lines 51-54).

Although the cited prior art does not expressly disclose the specific combination of applicant's formula I + sulfur, their combination as claimed by applicant would have been fairly suggested. First, both formula I and sulfur are known fungicides, known to protect valuable crop plants such as rice plants from phytopathogenic fungi. Second, both formula I and sulfur are known to be useful together in combination, resulting in at least increased efficacy or spectrum or synergism. Third, one having ordinary skill in the art would have been motivated to combine two fungicides in order to obtain the benefits of both fungicides. Fourth, one having ordinary skill in the art would have been motivated to adjust and optimize the concentration and application rates of the two component fungicides to arrive at the mixture concentration and mixture application rates, based on the individual concentration and application rates taught by the prior art.

It is recognized that the cited prior art does not expressly disclose 0.001 to 5 kg of the claimed mixture per 100 kg of seed, rice seed or otherwise. However, one of ordinary skill in the art would have been able to review typical industry rice seed

treatment amounts known for other fungicides to arrive at the claimed amounts (see Goddard and Duvert et al.). Even though the compounds in Goddard and Duvert et al. are different, EP 988790 is evidence that application amounts "can be readily determined by established biological tests." (paragraph 20).

Regarding dependent claims that specifically recite *Cochliobolus miyabenus* as the phytopathogenic fungi to be controlled, the prior art teaching of the genus as well as control of phytopathogenic fungi in rice are deemed fairly suggestive of this feature.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

In this regard, applicant's specification data has been reviewed for evidence of nonobviousness, but it must be noted that the data there falls short of being commensurate in scope with that of the claimed subject matter.

The test data disclosed on pages 10 and 11 were obtained by applying the active ingredients to leaves of rice seedlings at undeterminable actual application rates ("sprayed to runoff") by using 1 ppm or 4 ppm dilute solutions. The claims are open to any and all plants (though some dependent claims are limited to rice), any and all application amounts, concentrations, and proportions (though some dependent claims narrow these features), and any and all phytopathogenic fungi (though some dependent



claims are limited to *Cochliobolus miyabenus*). In other words, the claims being examined here are not limited to using 1-4 ppm dilute solutions, applied to rice seedlings, to control only *Cochliobolus miyabenus*. There is no evidence that the data obtained under such limited conditions would transfer similarly to other concentrations, proportions, plant types, plant substrate (e.g. seeds per se), and phytopathogens. As each of these variables are expected to have an effect on the performance of active agents, limited data such as applicant's cannot be considered probative evidence for the entire scope of the claimed subject matter.

For these reasons, all claims must be rejected.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/  
Primary Examiner, Art Unit 1616